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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,958	10/15/2001	Donald A. Phillips	02307Z-090130US	3597
20350	7590	01/28/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LANKFORD JR, LEON B	
		ART UNIT	PAPER NUMBER	
		1651		

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/831,958	PHILLIPS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	L Blaine Lankford	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

## DETAILED ACTION

The rejection under 35 USC 102(e) has been overcome by applicant's declaration and arguments.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 12-14 & 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams(5106648)

Williams teaches the application of beneficial microorganisms in a medium to improve the growth of plants. The microorganisms disclosed include *Rhizobium* (*Bradyrhizobium*) and *Pseudomonas* (see whole reference especially col 1). The reference teaches application to the soil, root or seeds of plants in particular soybeans (a legume).

The reference anticipates the claim subject matter.

Claims 1-9, 12-14 & 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroth et al(4849008)

Schroth teaches the application of a beneficial microorganism, *Pseudomonas* (see whole reference in particular the abstract) in a medium, to roots, plants, seeds, etc to improve the growth of plants including legumes.

The reference anticipates the claim subject matter.

Both references are silent on the presence of lumichrome and thus also the not the concentration or release rate thereof, however the prior art clearly teaches the application of the same microorganism in the same manner and thus the method inherently contains the claimed limitations. It is inherent to the methods of the prior art that lumichrome was applied (within a bacterial agent) for increasing the net growth of plants because the bacteria in used inherently contain lumichrome.

MPEP § 2112 explicitly states that

[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product - by - process claims. Quoting *In re Fitzgerald*, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (itself quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 - 34 (CCPA 1977)).

The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' utilized bacteria differ and, if so, to what extent, from that discussed in the references. Therefore, with the showing of the references, the burden of establishing novelty and/or non-obviousness by objective evidence is shifted to Applicants.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams and Schroth et al.

Williams teaches the application of beneficial microorganisms to improve the growth of plants. The microorganisms disclosed include *Rhizobium* (*Bradyrhizobium*) and *Pseudomonas* (see whole reference especially col 1). The reference teaches application to the soil, root or seeds of plants in particular soybeans (a legume).

Schroth teaches the application of a beneficial microorganism, *Pseudomonas* (see whole reference in particular the abstract), to roots, plants, seeds, etc to improve the growth of plants including legumes.

The references do not teach all of applicant's claimed embodiments, however as the references clearly indicate that the various proportions and amounts of the ingredients used in the claimed methods are result effective variables, they would be routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by those references.

The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Also, the discovery of an underlying mechanism of action does not make for a patentable invention when the method steps are the same or obvious, i.e. it is at least obvious to apply *Pseudomonas* and *Bradyrhizobium* to plants to improve the growth of the plants (a taught result) even though the effects of lumichrom were not previously known or recognized.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Blaine Lankford whose telephone number is 571-272-0917. The examiner can normally be reached on Mon-Thu 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



L Blaine Lankford  
Primary Examiner  
Art Unit 1651

LBL